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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,104	03/20/2002	Vladimir Gartstein	UICE-111.1 US(7922/84469)	5822
7590 08/27/2004 Thomas J Osborne The Procter & Gamble Company 8611 Beckett Road West Chester, OH 45069			EXAMINER ALEJANDRO, RAYMOND	
			ART UNIT 1745	PAPER NUMBER

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,104

Applicant(s)

GARTSTEIN ET AL.

Examiner

Raymond Alejandro

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003 and 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/28/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This office action is responsive to the amendment filed 08/28/03 and 09/22/03. The applicants have overcome most of the objections. Refer to the abovementioned amendment for specific details on applicant's rebuttal arguments and/or amendments. However, the present claims are finally rejected over the same art as seen below and for the reasons of record:

Information Disclosure Statement

1. The information disclosure statement filed 03/11/02 (paper # 3) still fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. In particular, the information disclosed in document number WO 92/03852 has not been considered. It is noted that applicants submitted on 08/28/03 a copy of WO 92/03853, however, the IDS paper lists document WO 92/03852 as indicated above.

Drawings

2. The proposed drawing corrections of 08/28/03 is accepted. As a formal matter, new replacement sheets of corrected drawings are still required in this application (as applicants only enclosed "marked-up" figures).

Claim Objections

3. Claim 5 is still objected to because of the following informalities: claim 5 recites the limitation "translucent" two times, thus it is redundant. Appropriate correction is required.

Specification

4. This application makes reference to an application (see page 5, lines 20-24), accordingly, the current status (whether abandoned or patented and its patent number) of all nonprovisional parent applications referenced should be included. *Applicants' cooperation to update such status is still requested in the event that applicants become aware of any change of the status.*

5. The amendments filed 08/28/03 and 09/22/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: (claim 1) "*and wherein the container and housing substantially enclose the electrochemical cell*". In this regard, nowhere in the original specification the examiner has found support for said limitation. That is, there is not indication throughout the entire specification that "the housing", in fact, "encloses the electrochemical cell". For example, the specification states the following: (at page 3, lines 10-17) "*The electrochemical cells need not be completely enclosed by a single structure.....but may not completely enclose the individual containers of the cells*"; (at page 4, lines 2-4) "*As used in this specification, a housing refers to an assembly that houses electronic circuitry*" (emphasis added, only electronic circuitry); (at page 4, lines 6-9) "*Such a housing may then be assembled together with the battery container*"; (at page 6, lines 23-30) "*Because the housing 10 is assembled separately from the electrochemical cell 22,.....Separately assembling the housing 10 allows for cleaner assembly process....*"; (at page 7, lines 5-13) "*As shown in Figure 5, the assembled housing 10 containing the electronic circuitry 16 is physically and electrically connected to an electrochemical cell 22. The assembled housing is associated with the battery container 24.*

However, the housing 10 is separate from the electrochemical cell 22. Preferably, the housing forms or contains a separate compartment for housing the electronic circuitry apart from the electrochemical cell 22...". Therefore, such limitation is unsupported by the original specification and is not even close enough to what applicants intended to disclose originally. Accordingly, no patentable weight at all has been given to such limitation, thus, it has not been further treated on the merits.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: (claim 1) "*and wherein the container and housing substantially enclose the electrochemical cell*". In this regard, nowhere in the original specification the examiner has found support for said limitation. That is, there is not indication throughout the entire specification that "the housing", in fact, "encloses the electrochemical cell". For example, the specification states the following: (at page 3, lines 10-17) "*The electrochemical cells need not be completely enclosed by*

a single structure.....but may not completely enclose the individual containers of the cells”; (at page 4, lines 2-4) *“As used in this specification, a housing refers to an assembly that houses electronic circuitry”* (emphasis added, only electronic circuitry, no battery at all); (at page 4, lines 6-9) *“Such a housing may then be assembled together with the battery container”;* (at page 6, lines 23-30) *“Because the housing 10 is assembled separately from the electrochemical cell 22,.....Separately assembling the housing 10 allows for cleaner assembly process....”;* (at page 7, lines 5-13) *“As shown in Figure 5, the assembled housing 10 containing the electronic circuitry 16 is physically and electrically connected to an electrochemical cell 22. The assembled housing is associated with the battery container 24. However, the housing 10 is separate from the electrochemical cell 22. Preferably, the housing forms or contains a separate compartment for housing the electronic circuitry apart from the electrochemical cell 22...”*. Therefore, such limitation is unsupported by the original specification and is not even close enough to what applicants intended to disclose originally. Accordingly, no patentable weight at all has been given to such limitation, thus, it has not been further treated on the merits.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

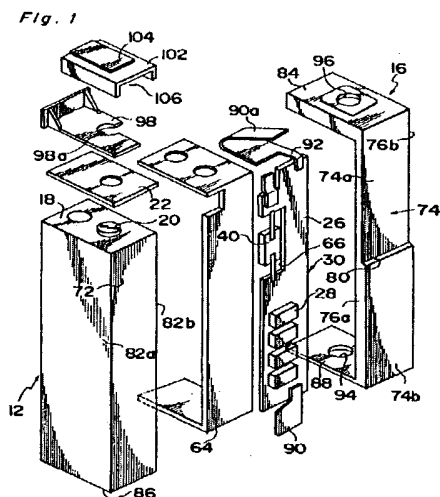
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

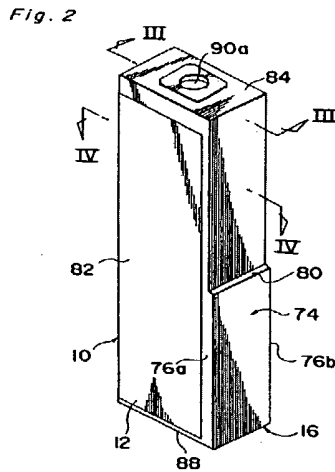
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The instant application is directed to a battery wherein the disclosed inventive concept comprises the specific circuitry externally connected to the electrochemical cell. Other limitations include the placement of the circuitry; and the specific housing components and connections.

Maruyama et al disclose a battery package 10 including a battery 12, an electronic circuit device 30 and a protective member 16 for enclosing the electronic circuit device 30 (*the housing containing electronic circuitry*) (col 3, lines 1-7). It is also disclosed that the battery includes an internal plus terminal 20 and an internal minus terminal 24 which are electrically connected with external plus and minus terminal members 90a and 90b of the battery package (col 3, lines 21-31/col 6, lines 58-64). As illustrated in Figures 1-2, the protective member 16 for enclosing the electronic device 30 is externally connected to the electrochemical cell or battery 12.





Maruyama et al teach that the electric circuit device include first control means for disabling a charging of the battery when a voltage across the battery exceeds a first upper limit voltage and for enabling the charging of the battery when the voltage across the battery lowers below a first lower limit voltage; a second control means for halting the charging of the battery when the voltage across the battery during the charging exceeds a second upper limit voltage, a third control means for interrupting a supply of an electric power to the first and second control means when a voltage supplied from an external source exceeds a third upper limit value (col 2, lines 14-30). Thus, the electronic circuitry measures and generates the cell voltage across the electrochemical generating member which are the positive electrode and the negative electrode of said cell.

It is also noted that Maruyama et al's invention generally relates to a secondary battery such as a lithium ion secondary battery (col 1, lines 5-10), thus, Maruyama et al inherently disclose the battery components such as the negative electrode and the positive electrode. It is noted that a battery requires a negative electrode and a positive electrode in order to properly operate and generate electrochemical energy. In this regard, Yukita et al is herein presented

to evidence that lithium ion secondary batteries require a positive electrode and a negative electrode (see ABSTRACT) to obtain a working battery. Hence, Yukita et al evidences Maruyama et al with respect to the foregoing subject.

With respect to claim 2:

As shown in Figures 1-2, the electronic circuitry 30 is physically isolated from or externally connected to the electrochemical cell 12. That is, the electronic circuitry is not disposed or placed inside or within the same container wherein the electrochemical cell is disposed.

Allowable Subject Matter

9. The following is a statement of reasons for the indication of allowable subject matter: a reasonable search for the prior art failed to reveal or fairly suggest what is instantly claimed, particularly: the housing including the specific components satisfying the specific structural relationship as recited in claims 3-10. (Refer to the prior office action of 06/24/03).
10. Claims 3-4 and 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. Claim 5 would be allowable if rewritten to overcome the objection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed 08/28/03 and 09/22/03 have been fully considered but they are not persuasive.

13. The primary contention of applicants' arguments is premised on the assertion that the prior art now fails to disclose "*the container and housing substantially enclosing the electrochemical cell, that is, the electrochemical is not substantially enclosed by a container and a housing*". In this respect, (as indicated above in items 5-6) the examiner has not given patentable weight and has not further treated such limitation on the merits because it is totally and completely unsupported and unfounded by the original disclosure. In this instance, neither the original specification nor the drawings provides, at least, a close indication that applicants originally and fundamentally intended to disclose such enclosed structure and/or a substantially similar embodiment (i.e. the electrochemical cell enclosed by the housing).

Note: the examiner recognizes and understands his duty to fully consider all limitations recited in the claims, but given that in this uncommon and rare circumstance nothing in the original specification discloses, states, supports and/or reveals at least something similar, analogous and/or close-enough to what applicants are now intending to recite, the unsupported limitation has not been further treated on the merits. Hence, it carries no patentable weight.

14. In response to applicant's argument that "*the claimed invention has functionality that is not provided by the cited reference...the prior art battery is a special purpose battery limited to custom-designed applications, whereas the claimed invention is directed to consumer batteries...*", the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability

when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (571) 272-1282. The examiner can normally be reached on Monday-Thursday (8:00 am - 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1745

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond Alejandro
Examiner
Art Unit 1745

A handwritten signature in black ink, appearing to read 'RAM', with a long horizontal line extending to the right.